

Applicant: Don Fishbein
Serial No.: 10/799,197
Filed: March 12, 2004
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REMARKS

Claims 30-45 are pending and under examination. Applicant has hereinabove amended claim 30. Support for the amendments to claim 30 can be found in the specification as originally filed at, *inter alia*, page 22, lines 14-16.

Priority

In the March 5, 2010 Office Action the Examiner objected to the currently claimed priority and asserted that U.S. Provisional Application No. 60/032,414 does not support the invention as instantly claimed. The Examiner asserted that the filing date of the present application, i.e. March 12, 2004, is considered the priority date of the presently claimed invention.

In response, applicant respectfully traverses the Examiner's rejection. Applicants have amended the claims to recite features supported in U.S. Provisional Application No. 60/032,414. With regard to the amendment to claim 30 hereinabove, applicant directs the Examiner's attention specifically to page 22, lines 14-16 of U.S. Provisional Application No. 60/032,414.

Accordingly, applicant maintains that the invention as currently claimed is supported in U.S. Provisional Application No. 60/032,414 and requests that the Examiner reconsider and recognize on the record applicant's December 5, 1996 priority date.

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Rejection of Claims Under 35 U.S.C. §112, New Matter

The Examiner rejected claims 30-45 and 47 as containing new matter and not complying with the written description requirement. The Examiner asserted that no support could be found for the limitation that the weight gained is maintained at five weeks after discontinuation of oxandrolone administration. The Examiner asserted that therefore that the claims are rejected because they contain new matter not supported by the specification.

In response, applicant respectfully traverses the Examiner's rejection. However, in order to expedite prosecution, and without conceding the correctness of the Examiner's position, applicant has hereinabove amended claim 30, from which the remaining claims depend, to recite "wherein the weight gained is maintained at eight weeks after discontinuation of oxandrolone administration". Applicant maintains that such is supported in the specification at page 22, lines 14-16. Accordingly, applicant respectfully requests that the Examiner reconsider and withdraw this rejection.

Rejection of Claims 30, 42-45 and 47 Under 35 U.S.C. §102(a)

Based on the Examiner recognizing only a March 12, 2004 priority date for the presently claimed invention, the Examiner rejected claims 30, 42-45 and 47 under 35 U.S.C. §102(a) as anticipated by Demling, *Burns* 29:793-797 (2003).

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In response, applicant respectfully traverses the Examiner's rejection. As amended herein the invention as currently claimed is supported in U.S. Provisional Application No. 60/032,414 and entitled to applicant's claimed December 5, 1996 priority date. As such, Demling is not prior art and the rejection should be withdrawn.

Rejection of Claims 30-40 Under 35 U.S.C. §103(a)

Based on the Examiner recognizing only a March 12, 2004 priority date for the presently claimed invention, the Examiner rejected claims 30-40 under 35 U.S.C. §102(a) as obvious over Demling, *Burns* 29:793-797 (2003) in view of Berger (U.S. Patent No. 6,090,799).

In response, applicant respectfully traverses the Examiner's rejection. The invention as currently claimed is supported in U.S. Provisional Application No. 60/032,414 and entitled to applicant's claimed December 5, 1996 priority date. As such, Demling is not prior art.

In addition, Berger (U.S. Patent No. 6,090,799), cited by the Examiner for disclosing administration of oxandrolone, does not suggest administration of oxandrolone for the treatment of weight loss resulting from post-burn catabolism. Berger also does not render obvious a method wherein the weight gained is maintained at eight weeks after discontinuation of oxandrolone administration. Accordingly, the obviousness rejection should be withdrawn.

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Rejection of claims 30 and 41 Under 35 U.S.C. §103(a)

The Examiner also rejected claims 30 and 41 under 35 U.S.C. §103(a) as allegedly obvious over Demling, Burns 29:793-797 (2003) in view of Labrie et al. (U.S. Patent No. 5,434,146).

In response, applicant respectfully traverses the Examiner's rejection. As amended herein the invention as currently claimed is supported in U.S. Provisional Application No. 60/032,414 and entitled to applicant's claimed December 5, 1996 priority date. As such, Demling is not prior art.

In addition, Labrie et al. (U.S. Patent No. 5,434,146), cited by the Examiner for disclosing administration of anabolic steroids in a sustained release formulation, does not suggest administration of oxandrolone to effect weight gain after weight loss resulting from post-burn catabolism. Labrie et al. also does not render obvious a method wherein the weight gained is maintained at eight weeks after discontinuation of oxandrolone administration. Accordingly, the obviousness rejection should be withdrawn.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicant's undersigned attorneys invite the Examiner to telephone them at the number provided below.

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SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT

In accordance with his duty of disclosure under 37 C.F.R. §1.56, applicant directs the Examiner's attention to the following items which are listed on the Form PTO-1449 (Substitute) attached hereto as **Exhibit A** and are also listed below. A copy of item 1 is attached hereto as **Exhibit 1**, respectively.

1. December 17, 2009 Office Action issued in connection with U.S. Serial No. 10/799,264 (**Exhibit 1**).

This Supplemental Information Disclosure Statement is being submitted under 37 C.F.R. §1.97(c)(4).

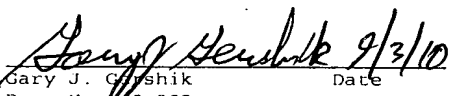
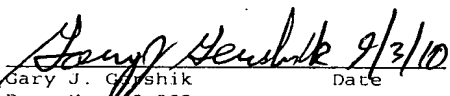
The Examiner is respectfully requested to make the listed items of record in the present application by initialing and returning a copy of the enclosed Form PTO-1449 (Substitute).

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicant's undersigned attorney invites the Examiner to telephone him at the number provided below.

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No fee, other than the enclosed total fee of \$960.00 including \$555.00 for a three-month extension of time and \$405.00 for filing an RCE, is deemed necessary in connection with the filing of this RCE, Amendment and Supplemental Information Disclosure Statement. However, if any additional fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,

I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop RCE Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450	
 Gary J. Gershik Reg. No. 39,992	 Date 9/3/10

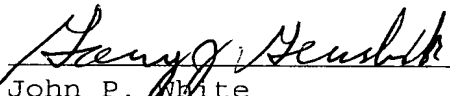

John P. White
Registration No. 28,678
Gary J. Gershik
Registration No. 39,992
Attorneys for Applicant
Cooper & Dunham LLP
30 Rockefeller Plaza,
20th Floor
New York, New York 10112
(212) 278-0400

EXHIBIT A

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